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Date: April 13, 2010 Name: Richard E. Stanley, Jr.

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Our Case No. 8627-1901
Client Ref. No. PA-5145-CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Henrik S. Klint et al.)	
)	Examiner: Julian W. Woo
Serial No.: 10/813,783)	
)	Group Art Unit No.: 3773
Filing Date: March 30, 2004)	
)	Confirmation No. 5211
For: AN EMBOLIZATION METHOD)	
FOR ENDOVASCULAR)	
OCCCLUSION)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Office Action dated March 10, 2010, Applicants request review of the final rejection in the above-identified application. As explained in more detail below, this review is being requested because of errors in the Examiner's rejections and the omission of elements needed for a prima facie rejection. A Notice of Appeal accompanies this Request.

The Examiner has rejected claims 1, 4-10, 12-17 and 21-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,994,069 ("Ritchart") in view of U.S. Patent No. 5,797,953 ("Tekulve"). The Examiner has also rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Ritchart in view of Tekulve in further view of U.S. Patent No. 5,122,136 ("Guglielmi"). The Examiner has also rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ritchart in

view of Tekulve and Guglielmi in further view of U.S. Patent No. 5,669,931 (“Kupiecki”). The Examiner has also rejected claims 11 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Ritchart in view of Tekulve and in further view of Kupiecki.

Applicants respectfully submit that the Examiner has misconstrued the claims. Under a proper interpretation of the claims, it is respectfully submitted that the combination of Richart and Tekulve does not disclose all of the limitations of Applicants’ claims. Therefore, at least Applicants’ independent claims cannot be rendered obvious by the proposed combination of Richart and Tekulve.

While the Examiner argues that his interpretation of the claims is appropriate under the doctrine that claims are given their broadest reasonable interpretation during examination, it is important to note that the Examiner’s interpretation must still be “reasonable” and must be “consistent with the specification.” MPEP §§ 904.01; 2111. “This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.” MPEP § 2111.01. “‘Plain meaning’ refers to the ordinary and customary meaning given to that term by those of ordinary skill in the art.” MPEP § 2111.01 (III). “The ordinary and customary meaning of the term may be evidenced by a variety of sources, including ‘the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.’ If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic evidence must be consulted to identify which of the different possible definitions is most consistent with applicant’s use of the terms.” MPEP § 2111.01 (III). It is respectfully submitted that when the entirety of Applicants’ claim language is considered in light of the specification, it is apparent that Richart and Tekulve do not disclose all of Applicants’ claim limitations.

In particular, Applicants’ claims recite that the wire body is “provid[ed]” with a section that is “substantially straight in [a] predetermined unloaded shape.” The wire body is then “insert[ed]” into a catheter and is “substantially in said predetermined unloaded shape within said catheter.” (Claim 20 “said catheter thereby loading said wire body into a substantially straight condition.”)

The terminology of a “predetermined unloaded shape” was added to the claims on August 1, 2008 in response to a § 112 rejection. This claim language replaced the previous claim language which recited that the section was substantially straight in a “relaxed condition.” In explaining the meaning of the new claim language, Applicants explained that the “term ‘predetermined unloaded shape’ is meant to define a state in which the wire body has no load or stress applied thereto.” This interpretation is consistent with the specification, which shows the wire body in several predetermined unloaded shapes in Figures 1-3 and 14 with a substantially straight section 4. (Page 10, lines 15-18; page 11, lines 1-3; page 11, line 6-7).

However, the Examiner’s interpretation of the claims is not consistent with the plain meaning of Applicants’ claim language. For example, the Examiner argues that “[t]he shape of the wire body section [in Ritchart] is largely predetermined in the sense that it is a wire formed into a coil-shape and straightened after being loaded within the catheter and prior to implantation in a patient’s body.” However, Applicants’ claims do not cover a wire body like Ritchart’s wire body, where the predetermined loaded shape is a coil, and the wire body is only straightened after being loaded into a catheter. In contrast, Applicants’ claims clearly recite that the section is “substantially straight in a predetermined unloaded shape.” In other words, the section is straight when no force is applied to the section. Another way to describe Applicants’ claim language is with the previous claim language that was replaced by the current language—the section is substantially straight when it is in a “relaxed condition.”

The Examiner also argues that “the wire body section is ‘substantially . . . unloaded’ in the sense that, while the wire body is in the catheter, it is not pushed, moved, or column-loaded before it is implanted in the patient’s body. The wire body section may be experiencing lateral forces from contact with the wall of the catheter lumen, but the wire body section is largely but not wholly (i.e., substantially) unloaded.” As explained above, what Applicants’ claims actually cover is a wire body section that is substantially straight when no force is applied to the section, and the wire body section is inserted into a catheter so that the section remains in its straight, unloaded condition. In other words, the catheter does not apply a force to the wire body section to straighten it. The Examiner, however, admits that the wire body in Ritchart takes a coil-shape

when no force is applied to the wire body. The Examiner also admits that Richart's wire body is only straightened "after" it is loaded into the catheter as a result of "experiencing lateral forces from contact with the wall of the catheter lumen." In effect, the Examiner agrees that Richart does not disclose the plain meaning of Applicants' claims.

However, the Examiner draws a distinction between column loading and lateral forces in an effort to maintain his rejection of the claims. But, this is not a distinction that applies to the specific claim language at issue. "Column loading" is referred to later in each of the claims with respect to mechanically pushing the wire body out of the catheter, but column loading is not referred to in the "providing" or "inserting" clauses of the claims. As explained above, the claim language simply means that the wire body section is substantially straight when no force is applied to the section. Thus, the wire body section must be substantially straight when no lateral forces are applied to the section, as well as when no column loading forces are applied to the section. However, as noted above, the Examiner has admitted that Richart does not disclose this limitation.

Accordingly, Applicants request reconsideration and allowance of the application.

Respectfully submitted,

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